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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,697	04/09/2004	Robert P. Bishop	31141-101	1539
26486 7590 04/01/2009 BURNS & LEVINSON, LLP 125 SUMMER STREET BOSTON, MA 02110				
EXAMINER				
PAINTER, BRANON C				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
04/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,697

Applicant(s)

BISHOP, ROBERT P.

Examiner

BRANON C. PAINTER

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4.8, 10-13 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) 4.8, 11, 12 and 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 10, 13 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 21 is objected to because of the following informalities:
 - a. Claim 21 attempts to limit the size of the aperture head and the size of the span of the feet by comparison to an unclaimed structure. Neither adjacent deck members or the gap therebetween are positively claimed; rather, they are introduced in a statement of intended use which cannot be relied upon for relative sizing purposes.
 - b. Claim 21, "high strength, corrosion resistant." For the purpose of this examination, the examiner presumes this should read "high-strength, corrosion-resistant."
 - c. Claim 21, "uniformally." For the purpose of this examination, the examiner presumes this should read "uniformly."
 - d. Claim 21, "aperture forming." For the purpose of this examination, the examiner presumes this should read "aperture-forming."
 - e. Claim 21, "being then constructed." For the purpose of this examination, the examiner presumes this should read "being constructed."
 - f. Appropriate correction is required for all preceding objections.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 10, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (1,435,887).
5. Regarding claim 21:
- a. Anderson discloses a clip (Figs. 2, 3) capable of securing objects to a top surface of a deck having spaced apart, and parallel to each other, elongated deck members with top and bottom surfaces and being of substantially uniform thickness, with sides of adjacent ones of the members substantially parallel to each other and spaced by a small gap in relation to member thickness, and including:
 - i. An elongated wire (c. 2, 75) of high-strength, corrosion-resistant material forming essentially the entirety of the clip.
 - ii. The wire shaped to provide an aperture-forming closed head (closed between 7, 8) and straight leg portions extending therefrom (10), adjacent to and essentially parallel one another (10), and terminating

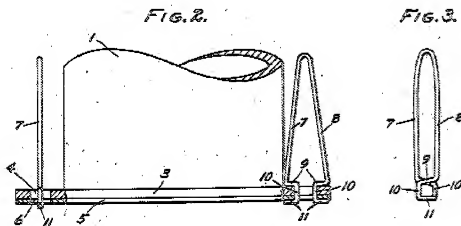
- in distal ends in feet orthogonal to the legs forming outward extending portions (11), all in a common plane.
- iii. The legs being of a length such that the wire clip is capable of insertion into a gap between adjacent deck members with its plane substantially parallel to the sides of those members past the full thickness thereof and then partially rotated and pulled upwards so the feet bear up against bottoms of those deck members and the aperture head also clears the member (Fig. 2).
 - iv. The clip being capable of being non-insertable between members and non-functional as a holding device unless inserted in a plane arrangement and partially rotated after said insertion (Fig. 2).
 - v. The aperture head and total span of the feet both being larger than the gap between said adjacent deck members and impassable through the gap unless the clip is oriented with its said plane substantially parallel to the side surfaces of the deck members on both sides of the gap and incapable of being pulled through the gap unless so oriented, the clip being capable of having the same form in all its positions (Fig. 2).
- b. Anderson does not expressly disclose that the wire diameter is about 1/8 inch.
 - c. It would have been an obvious matter of design choice to modify the clip of Anderson by giving it a diameter of about 1/8 inch, since applicant has not

disclosed that such diameter solves any stated problem or is for any particular purpose and it appears that the diameter of Anderson would perform equally well as a tie-down clip.

- d. The examiner notes that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *MPEP 2144.04*.
- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make the clip of Anderson with wire of about 1/8 inch diameter, as such diameter would allow the clip to be used in more heavy-duty applications.
- f. The examiner further notes applicant's admission that the "diameter of the wire employed is obviously selected for the specific intended use" ([0023]). Recitations of intended use are given little patentable weight.
- g. Claim 21 is considered to be a product-by-process claim. Applicant has repeatedly attempted to limit the claim by adding installation steps of the clip. However, the patentability of the product does not depend on its method of production or method of installation. Determination of patentability is based on the product itself. See MPEP 2113. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the

claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

- h. The examiner notes that, even if one were to give credence to these non-limiting statements of installation, the clip of Anderson is fully capable of being installed between two planks through a process of rotating, lowering between the planks, and rotating again in the same manner as applicant's clip is installed.



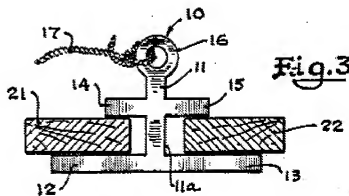
Reproduced from Anderson

6. Regarding claim 10, Anderson as modified above further discloses a clip head with multi-sided shape (Figs. 2, 3).
7. Regarding claim 13:
- a. Anderson as modified above further discloses a clip of spring-tempered material (c. 2, 74-76).
 - b. Anderson does not expressly disclose that the clip is made of stainless steel.
 - c. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the clip from stainless steel, since it has

been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

- d. Stainless steel is a well known material for use in making clips and would have been an obvious material choice at the time of the invention for its inherent material properties such as resilience and ease of shaping, along with the convenience of being readily available and inexpensive.
8. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunvalson (3,703,875) in view of Anderson (1,435,887).
9. Regarding claim 22:
- a. Gunvalson discloses a mooring device including:
 - i. A clip (10) in combination with a deck (21, 22) having spaced similar members with sides parallel to each other and adjacent members separated by small gap in relation to member thickness (Fig. 3), the clip having an aperture head portion (16) on top of the adjacent members and orthogonal thereto and feet (12, 13) below the members and orthogonal to the members to grip the members' undersides when a pulling up load is applied to the heads.
 - b. Gunvalson does not expressly disclose the combination employing a plurality of clips as claimed in claim 21.
 - c. Anderson discloses clips as set forth in regard to claim 21.

- d. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the clips of Gunvalson with clips as taught by Anderson, as both are equivalent clipping means and as the feet (11) of Anderson would grip the underside of the deck in the same manner as the feet (12, 13) of Gunvalson, and the lower edges (9) of the aperture of Anderson would grip the upper side of the deck in the same manner as the arms (14, 15) of Gunvalson, seeing as Gunvalson simply teaches mooring a device to a deck via a clip which can grip the deck.



Reproduced from Gunvalson

10. Regarding claim 23, Gunvalson/Anderson as modified above discloses a deck with clip devices, with Gunvalson further discloses members at least one inch thick and clips having legs at least as long as the thickness of the members (c. 3, 36-41).
11. Regarding claim 24:
- a. Gunvalson/Anderson discloses a deck with clip devices as set forth above.
 - b. Gunvalson/Anderson does not expressly disclose that the clip legs are at least one inch long.

- c. It would have been an obvious matter of design choice to modify the legs by making them at least one inch long, since applicant has not disclosed that such specific length solves any stated problem or is for any particular purpose and it appears that any leg length capable of locking the clip between adjacent deck members would perform equally well.
- d. The examiner notes that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *MPEP 2144.04.*

Response to Arguments

- 12. Applicant's arguments filed 02/09/09 have been fully considered but they are not persuasive.
- 13. The examiner notes that applicant has presented many arguments set forth in previous remarks, along with the date of their original presentation. The examiner's response to these arguments can be found in the prosecution history.
- 14. Applicant argues that Anderson's legs are not parallel, adjacent, or straight. However, Fig. 2 shows that legs 10 are parallel, adjacent, and straight. Furthermore, Fig. 2 shows Anderson's clip as it would be oriented when used with a deck.

15. Applicant argues that Anderson allows for a large range of compression, that the legs are not long enough to fit a deck, and that such clips are supposedly 10x smaller than applicant's clip. The examiner notes that, regardless of any supposed differences, the clip of Anderson meets the claim limitations, or makes obvious the diameter, as set forth in the rejection above.
16. Applicant argues that the deck combination is claimed in 21, and points to MECHANICS OF CLAIM DRAFTING. However, a claimed member cannot be further limited by reference to an unclaimed member. The examiner further notes that the patentability of claims is governed by the MANUAL OF PATENT EXAMINING PROCEDURE (MPEP), not the MECHANICS OF CLAIM DRAFTING.
17. Applicant argues that the material selection of stainless steel is not an obvious design choice. However, stainless steel is ubiquitous in both arts in question and it is certainly an obvious design choice to make an originally metal wire from stainless steel.
18. Applicant argues the Gunvalson/Anderson combination and claims ignorance as to how the references are combined. The examiner notes the combination is quite explicitly set forth above. Furthermore, the compression of Anderson would not have to be discarded, as Anderson is fully capable of being twisted into position in the same manner as applicant's clip as discussed above.
19. Applicant again argues the 132 declaration. The examiner refers applicant to the prosecution history regarding this declaration.

20. The examiner again notes that arguments against references not relied upon in the rejection are considered gratuitous. Any "extraordinary burden" resulting from the compilation of this list is the fault of the independent inventor, as the cited references are for applicant's benefit and are no way intended to be individually discussed unless they are relied upon in a rejection.

Conclusion

21. The examiner notes applicant's request for an interview, and invites applicant to call the examiner at (571) 270-3110 to arrange an interview time convenient for him.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./
Examiner, Art Unit 3633
/Basil Katcheves/
Primary Examiner, Art Unit 3635